



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/511,478

10/15/2004

Shigeyoshi Hasegawa

10873.1547USWO

4666

7590 04/15/2009  
HAMRE, SCHUMANN, MUELLER & LARSON,P.C.  
P.O. BOX 2902-0902  
MINNEAPOLIS, MN 55402

EXAMINER

LUONG, PETER

ART UNIT

PAPER NUMBER

3737

MAIL DATE

DELIVERY MODE

04/15/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/511,478	<b>Applicant(s)</b> HASEGAWA ET AL.	
	<b>Examiner</b> Peter Luong	<b>Art Unit</b> 3737	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/17/2009</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 5 is objected to because of the following informalities: in claim 5, the recitation of "formed of" is unclear whether it is inclusive or exclusive and the claim limitation appears to be directed to a method of manufacturing. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1 and 3-5 rejected under 35 U.S.C. 103(a) as being unpatentable over Crowley (US 5,715,825) in view of Abe (JP 2002078673).

Art Unit: 3737

5. Crowley teaches an ultrasonic probe (6), comprising an ultrasonic element (10) for transmitting and receiving ultrasonic waves (col. 14, line 59 -16); and a sound window (24) and (25) enclosing the ultrasonic element; and a sound propagation liquid (col. 11, lines 39-41 ) charged in the sound window, wherein a barrier layer (12) capable of inhibiting the permeation of liquids and gases (Abstract, lines 1-2) is provided on a wall surface of the sound window (col. 10, lines 41-42). See figures 1-5. Crowley teaches an elastic reserve tank (interior chamber of 12; col. 11, lines 39-41; figure 4).
6. Crowley does not explicitly teach the barrier layer comprising at least one selected from a polyparaxylylene layer and a metal layer, wherein the thickness of the polyparaxylylene layer is in the range from 0.1  $\mu\text{m}$  to 500  $\mu\text{m}$  and the polyparaxylylene layer is formed by vapor deposition of diparaxylylene or the derivative thereof.
7. Abe teaches a barrier located on an internal wall surface of a sound window (see abstract) wherein the barrier layer comprises a polyparaxylylene layer having a thickness in the range of 0.1  $\mu\text{m}$  – 75  $\mu\text{m}$  (Abstract) and being formed by vapor deposition of diparaxylylene or the derivative thereof ([0087], lines 1-2).
8. It would have been obvious to one having ordinary skill in the art at the time of the invention to form the barrier layer of polyparaxylylene in the Crowley invention, in light of the teaching of Abe in order to enhance the durability of the probe and increase impermeability characteristics of the barrier layer ([0081]). The range as taught by Abe is within the range disclosed by the applicant and therefore, teaches the range disclosed by the applicant.

Art Unit: 3737

9. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crowley (US 5,715,825) in view of Abe (JP 2002078673) and further in view of Law et al. (US 5,469,853).

10. Crowley does not teach the barrier layer comprising a metal layer and the metal layer comprising at least one selected from the group consisting of aluminum, gold, nickel and platinum, wherein the thickness of the layer in the range from 0.1 $\mu$ m – 30  $\mu$ m.

11. Law et al. teach the barrier layer, for example, a sheath, comprising a metal layer and the metal layer comprising at least one selected from the group consisting of aluminum, gold, nickel and platinum (col. 18, lines 52-53 and col. 35, lines 20-24), wherein the thickness of the layer is no greater than 0.4 mm (col. 18, lines 35-36).

12. It would have been obvious to one having ordinary skill in the art at the time of the invention to include a metal barrier layer, wherein the metal layer comprises at least one selected from the group consisting of aluminum, gold, nickel and platinum in the invention of Crowley in view of Abe, in light of the teachings of Law et al. in order to enhance the durability of the probe. The thickness of the barrier layer taught by Law et al. may be any value less than 0.4mm, which includes the values of the range claimed by the applicant. It would have been obvious to one having ordinary skill in the art at the time of the invention to select values within the range of 0.1  $\mu$ m - 30  $\mu$ m in order to have the most optimal barrier layer thickness required to effectively perform the procedure.

Art Unit: 3737

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crowley (US 5,715,825) in view of Abe (JP 2002078673) and further in view of Verdonk (US 5,640,961).

14. Crowley discloses the subject matter substantially as claimed except for the barrier layer comprising a plurality of layers. Verdonk teaches the barrier layer comprising a plurality of layers (col. 8, lines 9- 10 and lines 13-16).

15. It would have been obvious to one having ordinary skill in the art at the time of the invention to include a barrier layer comprising a plurality of layers in the Crowley in view of Abe apparatus, in light of the teaching of Verdonk in order to improve focusing of the ultrasonic beam (col. 8, lines 13-18).

### ***Response to Arguments***

Applicant's arguments filed 1/9/2009 have been fully considered but they are not persuasive.

Applicant argues that Crowley does not teach a grip portion because it is a catheter. However, the Examiner respectfully disagrees with the applicant. The Examiner notes that Crowley inherently has a grip portion in order for the catheter to be handled. Especially in the case in which the catheter is to be inserted into a subject, as the physician or operator must inherently grip the catheter in order to insert it into the subject.

Applicant argues that Crowley does not teach the use of a barrier layer to maintain pressure inside a sound window and a reserve tank that absorbs changes of pressure of the charged sound propagation fluid. However, the Examiner respectfully

Art Unit: 3737

disagrees with the applicant. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

16. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., 100psi) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. Applicant argues Abe teaches an optical instrument and does not teach an ultrasound probe. However, the Examiner respectfully disagrees with the applicant. The Examiner has relied upon Abe to teach the barrier layer in order to enhance the durability of the probe and increase the impermeability characteristics of the barrier layer ([0081]). Applicant argues one of ordinary skill in the art would not consider the teachings of an optical instrument when considering improvements to an acoustic device. However, the Examiner respectfully disagrees with the applicant. Both the optical and acoustic devices are intended to be used within a subject in which exposes fluid to the device. Abe teaches the barrier layer in order to increase impermeability of liquids. It is advantageous for any device, whether optical or acoustic, to be provided with the barrier layer in order to prevent external liquids from entering the device or vice versa.

***Conclusion***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Luong whose telephone number is (571)270-1609. The examiner can normally be reached on Monday - Friday, 9:30 a.m. - 6:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (571) 272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3737

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRIAN CASLER/  
Supervisory Patent Examiner, Art  
Unit 3737

/P. L./  
Examiner, Art Unit 3737